

**HARNESS, DICKEY & PIERCE, P.L.C.**

Attorneys and Counselors  
 7700 BonHomme, Suite 400  
 Clayton, MO 63105  
 Phone: 314-726-7500  
 Fax: 314-726-7501  
 Troy, MI • Washington, D.C.

DATE: April 29, 2004

NO. OF PAGES (INCLUDING THIS PAGE): 10

FOR:	Office of Initial Patent Examination's Filing Receipt Corrections	ORIGINAL WILL FOLLOW BY: <input type="checkbox"/> REGULAR MAIL <input type="checkbox"/> OVERNIGHT MAIL <input type="checkbox"/> COURIER <input checked="" type="checkbox"/> WILL NOT FOLLOW
COMPANY:	Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	
FAX No.:	1-703-746-9195	PHONE:

FROM: Lydia N. Nenow

Please let us know by phone or fax if you do not receive any of these pages.

COMMENTS:	
Application of: Thomas E. Barta et al. Serial No: 10/747,796 Filed: December 29, 2003 Title: Aromatic Sulfone Hydroxamic Acid Metalloprotease Inhibitor Art Unit: 1625 Examiner: Unknown Confirmation No: 6418 Attorney Docket No: 3124/5A/US HDP Docket No: 6794-0000017/DVF	

## \*\*\* NOTICE \*\*\*

The information contained in this telefax transmission is intended only for the individual to whom or entity to which it is addressed. It may also contain privileged, confidential, attorney work product or trade secret information which is protected by law. If the reader of this message is not the intended recipient, or an employee or agent responsible for delivering the message to the addressee, the reader is hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone and return the original message to us at the address above via the U.S. Postal Service. We will reimburse you for any reasonable expense (including postage) for the return of the original message.

PAGE 1/11 \* RCVD AT 4/29/2004 7:50:02 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-2/0 \* DNIS:7469195 \* CSID:314 726 7501 \* DURATION (mm:ss):03-08

BEST AVAILABLE COPY

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Thomas E. Barta et al.  
Serial No: 10/747,796  
Filed: December 29, 2003  
Title: Aromatic Sulfone Hydroxamic Acid Metalloprotease Inhibitor  
Art Unit: 1625  
Examiner: Unknown  
Confirmation No: 6418  
Attorney Docket No: 3124/5A/US  
HDP Docket No: 6794-0000017/DVF

April 29, 2004

**REQUEST FOR CORRECTION OF FILING RECEIPT**

Office of Initial Patent Examination's Filing Receipt Corrections  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir/Madam:

Applicants respectfully request that the U.S. Patent and Trademark Office issue a corrected filing receipt in the above-referenced patent application. The filing receipt does not list the complete priority claims for U.S. Patent Application Serial Nos. 09/311,837 and 09/256,948. Those applications claim priority to U.S. Provisional Patent Application Serial No. 60/066,007 in addition to the rest of the applications enumerated in the filing receipt.

In support of their request, Applicants have enclosed the following:

1. A copy of page 2 of Applicants' December 29, 2003 Preliminary Amendment A.
2. A copy of the filing receipt.
3. A marked up copy of the filing receipt showing the priority claims of U.S. Patent

Application Serial Nos. 09/311,837 and 09/256,948 to U.S. Provisional Patent

Application Serial No. 60/066,077.

U.S. Patent Application No. 10/747,796  
April 29, 2004  
Request for Correction of Filing Receipt

\* \* \* \* \*

Applicants believe that they do not owe any fee in connection with this request. If, however, Applicants do owe a fee, the Commissioner is hereby authorized to charge the deficiency or overpayment to Deposit Account No. 08-0750. In addition, if there is ever any fee deficiency or overpayment in connection with this patent application, the Commissioner is hereby authorized to charge such deficiency or overpayment to Deposit Account No. 08-0750.

Respectfully submitted,



Lydia N. Nenow, PTO Reg. No. 52,530  
Harness, Dickey & Pierce, P.L.C.  
7700 Bonhomme, Suite 400  
St. Louis, Missouri 63105  
(314) 726-7500 (tel)  
(314) 726-7501 (fax)

**CERTIFICATE OF FACSIMILE**

I certify that this correspondence has been faxed on April 29, 2004 to facsimile number 1 703 746 9195 and addressed to the attention of Office of Initial Patent Examination's Filing Receipt Corrections, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Peggy Marie Leslie

LNN/PML

**Preliminary Amendment A****Appl. No. TBA****December 29, 2003****Amendments to the Specification**

**Please replace the paragraph bridging lines 7-12 on page 1 with the following new paragraph:**

This patent is a divisional of U.S. Application Serial No. 09/570,731 (filed on May 12, 2000), which, in turn, is a continuation-in-part of U.S. Application Serial Nos. 09/311,837 (filed on May 14, 1999) and 09/256,948 (filed on February 24, 1999). U.S. Application Serial No. 09/311,837 claims priority as a continuation-in-part of U.S. Application Serial Nos. 09/256,948, 09/191,129 (filed on November 13, 1998), and 09/186,410 (filed on November 5, 1998); and also claims priority to U.S. Provisional Application Serial Nos. 60/066,007 (filed on November 14, 1997), 60/095,347 (filed on August 4, 1998), 60/095,501 (filed on August 6, 1998), and 60/101,080 (filed on September 18, 1998). U.S. Application Serial No. 09/256,948 claims priority as a continuation-in-part of U.S. Application Serial Nos. 09/191,129 and 09/186,410; and also claims priority to U.S. Provisional Application Serial Nos. 60/066,007, 60/095,347, 60/095,501, and 60/101,080. U.S. Application Serial No. 09/191,129 claims priority as a continuation-in-part of U.S. Application Serial No. 09/186,410; and also claims priority to U.S. Provisional Application Serial Nos. 60/066,007, 60/095,347, 60/095,501, and 60/101,080. And U.S. Application Serial No. 09/186,410 claims priority to U.S. Provisional Application Serial Nos. 60/066,007, 60/095,347, 60/095,501, and 60/101,080. The entire text of each of the above-referenced patent applications are incorporated by referenced into this patent.

**Please replace the paragraph bridging lines 15-25 on page 1 with the following new paragraph:**

This invention is directed to proteinase (protease) inhibitors, and more particularly to the use of aromatic sulfone hydroxamic acid compounds (including hydroxamates) that, *inter alia*, are selective inhibitors of matrix metalloproteinases in a process for treating conditions associated with pathological matrix metalloproteinase activity, the selective inhibitors themselves, compositions of proteinase inhibitors, intermediates for the syntheses of proteinase inhibitors, and processes for the preparation of proteinase inhibitors.



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/747,796	12/29/2003	1625	1274	3124/5A/US (6794-000017/D)		48	2

28997

HARNESS, DICKEY, & PIERCE, P.L.C.  
 7700 BONHOMME, STE 400  
 ST. LOUIS, MO 63105

R E C E I V E D  
 APR 15 2004

## FILING RECEIPT

RECEIVED  
 \*OC000000012328147\*

HARNESS, DICKEY & PIERCE  
 ST. LOUIS, MISSOURI

Date Mailed: 04/12/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

- Thomas E. Barta, Wilmette, IL;
- Daniel P. Becker, Glenview, IL;
- Louis J. Bedell, Mt. Prospect, IL;
- Terri L. Boehm, Ballwin, MO;
- Jeffery N. Carroll, Columbia, IL;
- Gary A. DeCrescenzo, St. Charles, MO;
- Yvette M. Fobian, Wildwood, MO;
- John N. Freskos, Clayton, MO;
- Daniel P. Getman, Chesterfield, MO;
- Susan L. Hockerman, Lincolnwood, IL;
- Carol P. Howard, Fenton, MO;
- Stephen A. Kolodziej, Ballwin, MO;
- Madeleine H. Li, Vernon Hills, IL;
- Joseph J. McDonald, Wildwood, MO;
- Debrah A. Mischke, Defiance, MO;
- Joseph G. Rico, O'Fallon, MO;
- Nathan W. Stehle, Grafton, WI;
- Michael B. Tolleson, Hainesville, IL;
- William F. Vernier, St. Louis, MO;
- Clara I. Villamil, Glenview, IL;

## Domestic Priority data as claimed by applicant

- This application is a DIV of 09/570,731 05/12/2000 which is a CIP of 09/311,837 05/14/1999 and is a CIP of 09/256,948 02/24/1999 ABN and said 09/311,837 05/14/1999

is a CIP of 09/256,948 02/24/1999 ABN  
and is a CIP of 09/191,129 11/13/1998 ABN  
and is a CIP of 09/186,410 11/05/1998 ABN  
and claims benefit of 60/095,347 08/04/1998  
and claims benefit of 60/095,501 08/06/1998  
and claims benefit of 60/101,080 09/18/1998  
and said 09/256,948 02/24/1999  
is a CIP of 09/191,129 11/13/1998 ABN  
and is a CIP of 09/186,410 11/05/1998 ABN  
and claims benefit of 60/095,347 08/04/1998  
and claims benefit of 60/095,501 08/06/1998  
and claims benefit of 60/101,080 09/18/1998  
and said 09/191,129 11/13/1998  
is a CIP of 09/186,410 11/05/1998 ABN  
and claims benefit of 60/066,007 11/14/1997  
and claims benefit of 60/095,347 08/04/1998  
and claims benefit of 60/095,501 08/06/1998  
and claims benefit of 60/101,080 09/18/1998  
and said 09/186,410 11/05/1998  
claims benefit of 60/066,007 11/14/1997  
and claims benefit of 60/095,347 08/04/1998  
and claims benefit of 60/095,501 08/06/1998  
and claims benefit of 60/101,080 09/18/1998

**Foreign Applications****If Required, Foreign Filing License Granted: 04/09/2004****Projected Publication Date: To Be Determined - pending completion of Missing Parts****Non-Publication Request: No****Early Publication Request: No****Title**

Aromatic sulfone hydroxamic acid metalloprotease inhibitor

**Preliminary Class**

514

---

**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15****GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted

under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

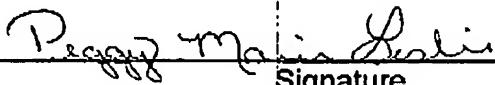
PTO/SB/97 (08-03)

Approved for use through 07/31/2006, OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.**Certificate of Transmission under 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the attention of Office of Initial Patent Examination's Filing Receipt Corrections, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 at fax number 1-703-746-9195 on April 29, 2004.



Signature



Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Request for Correction of Filing Receipt (2 pages)  
Copy of Page 2 of Preliminary Amendment A (1 page)  
Copy of Filing Receipt (3 pages)  
Marked up Copy of the Filing Receipt (3 pages)

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.